

REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated April 3, 2009 (“*Office Action*”). At the time of the *Office Action*, Claims 1-11 and 13-27 were pending and rejected. Applicants have amended Claims 1 and 20. Claim 12 was previously canceled. Applicants submit that no new matter has been added by these amendments. As described below, Applicants believe all claims to be allowable over the cited references. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

Section 101 Rejections

The Examiner rejects Claims 1-6, 8-11, and 13-27 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. It is the Examiner’s position that “[t]he claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.” (*Office Action*, page 2). Without conceding the veracity of the rejection, Applicant has amended independent Claim 1 to more clearly recite “providing one or more computer-systems associated with the returns provider, the one or more computer-systems providing returns services to a plurality of customers communicating with the one or more computer-systems over a network.” Claim 1 also recites “using the one or more computer-systems associated with the processing center to determine a transaction-specific shipping destination of the package, the transaction-specific shipping destination comprising a postal center located closest to the customer.” Claim 20 has been amended to recite certain similar claim elements. Thus, at least the amended language of Claims 1 and 20 make clear that the methods are tied to a computing system. Because a computer system is a “machine,” the methods of Claims 1 and 20 are “tied to a particular machine.” Therefore, the methods recited in Claims 1 and 20 constitute statutory subject matter under 35 U.S.C. § 101 according to the applicable case law.

For at least these reasons, Applicant respectfully submits that independent Claims 1 and 20 and their respective dependent claims meet the requirements of 35 U.S.C. § 101 and respectfully request that the 35 U.S.C. § 101 rejections of these claims be withdrawn. Favorable action is requested.

Section 112 Rejections

The Examiner rejects Claims 1-27 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner states that “it is not clear as to what the scope of “conforms to the USPS merchandise return service specifications” is. “ (*Office Action*, page 3). Applicants have amended the claims to address the antecedent basis issues identified by the Examiner. Applicants respectfully request that the rejections under 35 U.S.C. § 112, second paragraph be withdrawn.

Section 102 Rejections

The Examiner rejects Claims 1-5, 7, 9-11, 14-21, 23, and 26 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,536,659 issued to Hauser et al. (“*Hauser*”). Applicants respectfully request reconsideration for at least the following reasons.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. ch. 2131. “The *identical invention* must be shown in as *complete detail as contained* in the . . . claim .” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added); see also M.P.E.P. ch. 2131. In addition, “[t]he elements must be arranged as required by the claim.” *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. ch. 2131.

The Federal Circuit recently clarified this standard in *Net Moneyin, Inc. v. Verisign, Inc.*, 2008 WL 4614511 (Fed. Cir. 2008). In *Net Moneyin*, the Federal Circuit held that a finding of anticipation under 35 U.S.C. § 102 is proper only when a “reference discloses within the four corners of the document not only all of the limitations claimed but also *all of the limitations arranged or combined in the same way* as recited in the claim.” *Net Moneyin* at *10 (emphasis added). The prior art reference must “*clearly and unequivocally* disclose the claimed invention . . . *without any need for picking, choosing, and combining various disclosures not directly related to each other by* the teachings of the cited reference.” *Id.* (emphasis added, internal typographical notations omitted).

Independent Claim 1 of the present Application, as currently amended, recites:

A method, performed by a returns provider, of enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising the step of:

providing one or more computer-systems associated with the returns provider, the one or more computer-systems providing returns services to a plurality of customers communicating with the one or more computer-systems over a network;

using the one or more computer-systems associated with the processing center to determine a transaction-specific shipping destination of the package, the transaction-specific shipping destination comprising a postal center located closest to the customer;

using the one or more computer-systems to provide the customer with a return label to be placed on the package, the label containing the transaction-specific shipping destination of the package and integrated machine readable data representing at least a shipping origin of the package and identification of the transaction;

using a postal service to transport the package to the postal center located closest to the customer; and

holding the package at the postal center located closest to the customer for pick-up by the returns provider.

Whether considered alone or in combination with any other cited references, *Hauser* does not disclose, either expressly or inherently, each and every element of the claims.

For example, *Hauser* does not disclose, teach, or suggest “using the one or more computer-systems associated with the processing center to determine a transaction-specific shipping destination of the package, the transaction-specific shipping destination comprising a postal center located closest to the customer” and then “using a postal service to transport the package to the postal center located closest to the customer . . . and . . . holding the package at the postal center located closest to the customer for pick-up by the returns provider,” as recited in Claim 1. To the contrary, *Hauser* discloses that “the customer will be the party that ships the merchandise being returned to the return facility.” (*Hauser*, Column 3, line 67 through Column 4, line 2). *Hauser* further discloses that the shipping label will include “the address for Returns Online, Inc.” and that the label can be used “to facilitate shipment of the merchandise to Returns Online, Inc.” (*Hauser*, Column 4, lines 16-35). Thus, *Hauser* makes clear that the destination of the package, as identified on the shipping label, is the actual return facility. Thus, *Hauser* does not disclose, teach, or suggest “using the one or more computer-systems associated with the processing center to determine a

transaction-specific shipping destination of the package, the transaction-specific shipping destination comprising a postal center located closest to the customer” and then “using a postal service to transport the package to the postal center located closest to the customer . . . and . . . holding the package at the postal center located closest to the customer for pick-up by the returns provider,” as recited in Claim 1.

For at least these reasons, Applicants request reconsideration and allowance of independent Claim 1, together with Claims 2-5, 7-11, and 14-19 that depend on Claim 1. For analogous reasons, Applicants request reconsideration and allowance of independent Claim 20, together with Claims 21 and 23 that depend on Claim 20.

Section 103 Rejections

The Examiner rejects Claims 6, 8, 22, 24, and 27 under 35 U.S.C. 103(a) as being unpatentable over *Hauser*. The Examiner rejects Claims 13 and 25 under 35 U.S.C. 103(a) as being unpatentable over *Hauser* in view of U.S. Patent No. 6,085,172 issued to Junger (“*Junger*”).

Each of dependent Claims 6, 8, and 13 depend on Claim 1. Dependent Claims 22, 24, 25, and 27 depend on Claim 20. Accordingly, dependent Claims 6, 8, 13, 22, 24, 25, and 27 are not obvious over *Hauser* or the proposed *Hauser-Junger* combination at least because Claims 6, 8, 13, 22, 24, 25, and 27 include the limitations of their respective independent claims, which Applicants have shown above to be allowable. Since Claims 6, 8, 13, 22, 24, 25, and 27 incorporate the limitations of their respective independent claims, Applicants have not provided detailed arguments with respect to these claims. However, Applicants remain ready to do so if it becomes appropriate. Applicants respectfully request reconsideration and allowance of Claims 6, 8, 13, 22, 24, 25, and 27.

For at least these reasons, Applicants request reconsideration and allowance of Claims 6, 8, 13, 22, 24, 25, and 27.

No Waiver

Additionally, Applicants have merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not

acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner's rejections.

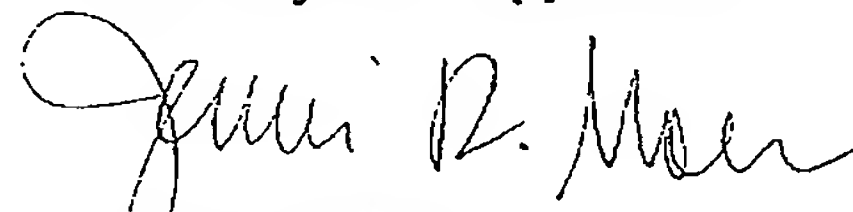
CONCLUSION

Applicants have made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicants, at the Examiner's convenience at (214) 415-4820.

No fees are believed due; however, the Commissioner is hereby authorized to charge any fees or credits to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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